

In re Appln. of Peter Bongartz et al.  
Serial No. 10/680,923  
Reply To Office Action Of December 17, 2004

#### REMARKS

This Amendment is responsive to the Office Action mailed December 17, 2004 wherein the Examiner (a) objects to the drawings as having reference numerals that are used to identify features in the prior art and then reused to identify modification of such features in the invention; (b) objects to the drawings because reference numeral 18 appears in Fig. 2, but does not appear in the description; (c) objects to the specification because the abstract of the disclosure starts with a phrase that can be implied; (d) rejects Claims 15 and 16 under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and claim the subject matter which the Applicants regard as the invention; (e) rejects Claim 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,525,109 to Hofmann et al; (f) rejects Claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,270,815 to Olschewski et al; (f) rejects Claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,317,602 to Orain; (g) rejects Claims 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,412,985 to Schweitzer et al; and (h) states that Claims 15 and 16 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 second paragraph and to include all the limitations of the base claim and any intervening claims. By this response, Applicants amend Claim 15, cancel Claims 7-11 and respectfully submit that each of the pending Claims 12- 16 are in a condition for allowance.

The Examiner rejected Claim 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,525,109 to Hofmann et al. Applicants respectfully traverse this rejection as conceivably applied to Claim 12.

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It is well settled that anticipation can only be established by a single prior art reference which identically discloses each and every element of the claimed invention. Anticipation is not shown, even if the differences between the claims and the prior art reference is insubstantial. Instead, the cited reference must show exactly what is claimed. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); Structured Prod. Co. v. Park Rubber Co., 749 F.2d 707, 233 U.S.P.Q. 1264 (Fed. Cir. 1984).

Applicants respectfully submit that Claim 12 is not anticipated by Hofmann because it does not disclose exactly what is claimed. Hofmann is directed to a tripod joint with a roller securing ring. As shown in Fig. 3, and described in Col. 4, Lns. 38-46 of Hofmann, the roller assembly includes a securing ring 8 having a gap 7 required for assembly purposes and which extends at an angle relative to a radial ray C through the roller axis. Hofmann further states, the width b of the gap should be smaller than/equal to 0.6 times the diameter d of a bearing needle, whereas for functional reasons, the width c of the securing ring 8 is greater than the diameter of a bearing needle. The Examiner states that Fig. 3 shows the retaining ring including a fracture area.

Applicants respectfully submit that Hofmann does not show the fracture area as claimed in Claim 12. Much to the contrary, Hofmann discloses only a gap, not a fracture area that is fractured as the retaining ring is secured in said retaining groove. The gap in Hofmann is exactly like the pre-cut gaps that the present invention defines over. Hofmann does not disclose a fracture area that is fractured as the retaining ring is secured in the retaining groove, and therefore Hofmann does not disclose each and every element of the invention as claimed in

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Claim 12. Therefore, Applicants respectfully request withdrawal of this rejection. Applicants also respectfully submit that the subject matter of the amended claims is not obvious over Hofmann because there is no motivation in the art for modifying Hofmann to obtain the subject matter of Claim 12.

The Examiner rejected Claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,270,815 to Olschewski et al. Applicants respectfully traverse this rejection as conceivably applied to Claims 12 and 13.

Olschewski is directed to a roller bearing, and more particularly to an edge ring that is slit in at least one location about its periphery (Col. 1, Lns. 5-10). The ring 12 is slit at one location on the periphery as best can be seen in Fig. 2 to accommodate an insert 14 that fits between the outer terminal end faces of the separation joint of the edge ring (Col. 2, Lns. 23-26). The insert is secured by means of screws 15 to the outer ring of the bearing, with the insert 14 filling and closing the gap formed by the separation joint of the edge ring, serves as a brace of the edge ring and prevents rotation of the edge ring in relation to the outer ring 2 (Col. 2, Lns. 26-31). The edge ring is provided with a cut out or recess 18 at a location diametrically opposite the separation joint to define an area of smaller cross section providing a hinge to deform the edge ring for the purposes of inserting it into the annular grooves 10 and 11 (Col. 2, Lns. 38-43). The edge ring is assembled by compressing it slightly in a radial direction whereby it deforms uniformly about the cut out or recess 18 and once seated in the groove it flexes outwardly to fill the groove (Col. 2, Lns. 59-65). Fig. 3 shows a modified form of edge ring design where the separation joints between insert 14' and edge ring are designed with an

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incline (Col. 3, Lns. 9-22). In this embodiment, the edge ring is separated by slits or breaks at the location diametrically opposite the insert 14' (Col. 3, Lns 22-25). As a result of these slits or breaks, the installation of the edge ring is made substantially easier, especially in bearings having large diametral dimensions (Col. 3, Lns 25-31).

The Examiner states that Fig. 3 shows the retaining ring 12' includes a fracture area 18a and Fig. 1 shows the retaining ring with a first leg 9 having an inner surface and a second leg 12 having an outer surface and a first notch defined by the second leg.

Applicants respectfully submit that Olschewski does not disclose a fracture area as claimed in Claim 12. Much to the contrary, Olschewski only discloses in Fig. 3, an edge ring that is deformed or at most a two part ring that is separated in two places for large diameter rings. This deformation area or separation, as described in Olschewski, is the opposite of the fracturing area of the present invention. Olschewski does not disclose nothing more than an area that is deformed in one embodiment or separate pieces in another embodiment. As a result, Olschewski embodies precisely that which the present invention is designed to overcome, especially the embodiment in Fig. 3 which includes at least three separate portions of an edge ring that need to be held in place with screws.

The present invention is directed to, as claimed in Claim 12, a ring with a fracture area that is fractured as the retaining ring is secured in the retaining groove, thereby providing easy assembly. Dependent Claim 13 provides additional limitations of a first leg and a second leg, which applicants can find no mention of in Olschewski. The Examiner states that Fig. 1 shows the retaining ring having a first leg 9 and a second leg 12, however in the specification these

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reference numerals refer to a loose rim disc 9 (Col. 1, Lns. 16-17) and an edge ring 12 (Col. 1, Ln. 21). Applicants do not see how these two separate items form a first and second leg of a retaining ring, as claimed in Claim 13 and respectfully submit that Olschewski does not disclose a retaining ring with a first and second leg.

Given that Olschewski does not disclose each and every element of Claims 12 and 13, Applicants respectfully request withdrawal of this rejection. Applicants also respectfully submit that the subject matter of the amended claims is not obvious over Olschewski because there is no motivation in the art for modifying Olschewski to obtain the subject matter of the Claims 12 and 13.

The Examiner rejected Claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,317,602 to Orain. Applicants respectfully traverse this rejection as conceivably applied to Claims 12 and 13.

Orain is directed to a journal which is part of a tripod, with a roller mounted thereon and needles therebetween. The assembly is completed by a split ring 8, received in a groove. (Col. 2, Lns. 27-37). Orain does not disclose a retaining ring having a fracture area that is fractured when the retaining ring is secured within the retaining groove. Orain does not disclose, teach or suggest a fracture area and only refers to a split ring. Furthermore, reference numerals 7 and 8 point to two separate items, a ring 8 and an annular member or cup 7. This is substantially the same as Figure 1 of the Applicant's drawings, labeled as prior art, which show a ring 14 and an annular member or cup 12. Therefore, Orain is exactly that which the present invention is designed to overcome. In further regards to dependent claim 13, the split ring, as shown in

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Orain does not include a first leg and a second leg. Therefore, Orain does not disclose each and every element of Claims 12 and 13, and Applicants respectfully request withdrawal of this rejection. Applicants also respectfully submit that the subject matter of the amended claims is not obvious over Orain because there is no motivation in the art for modifying Orain to obtain the subject matter of the Claims 12 and 13.

The Examiner rejected Claims 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,412,985 to Schweitzer et al. Applicants respectfully traverse this rejection as conceivably applied to Claims 12-14.

Schweitzer is directed to a flanged ring for fixing a bearing in place. The flanged ring 1 is provided with a break 4 in at least one location along its circumferential extent to thus form a split flanged ring. The flanged ring 1 thus possesses two separate end regions 6, 7 that generally adjoin and meet one another at a location of the break in the ring.

Again, as stated above, Schweitzer fails to disclose, teach or suggest a fracture area that fractures as the retaining ring is secured in the retaining groove and specifically there is no mention of a fracture area. In further regards to dependent claim 13, Schweitzer fails to disclose a first leg and a second leg, with a notch defined by on of the first and second legs. Even if Schweitzer could be considered to have two legs as suggested by the Examiner, the notch would be defined between the two legs, and not by one of the legs as claimed in Claim 13. Claim 14 includes a second notch defined by the other leg, which clearly is not disclosed by Schweitzer, as the notches are defined between the two legs and not one notch by each leg, if

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the items referred to by the Examiner could be considered legs as defined by the present invention.

Given that Schweitzer et al does not disclose each and every element of Claims 12-14, Applicants respectfully request withdrawal of this rejection. Applicants also respectfully submit that the subject matter of the amended claims is not obvious over Schweitzer because there is no motivation in the art for modifying Schweitzer to obtain the subject matter of the Claims 12-14.

Applicants also submit a replacement drawing sheet for Figure 1 and a replacement paragraphs [0003] and [0021] and respectfully request withdrawal of the Examiner's objection to the drawings.

Applicants have amended Claim 15 to overcome the Examiner's rejection under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and claim the subject matter which the Applicants regard as the invention. Applicants have also amended Claim 15 to include all limitations of the base claim and intervening claims and submit that amended Claim 15 and dependent Claim 16 is in a condition for allowance.

Applicants have submitted a replacement abstract of the disclosure, showing amendments and respectfully request withdrawal of the Examiner's objection to the specification.

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In view of the above remarks and the revised claims, Applicants submit that each of the pending claims define an invention that is patentable over the prior art. Prompt and favorable consideration of this amendment is respectfully requested.

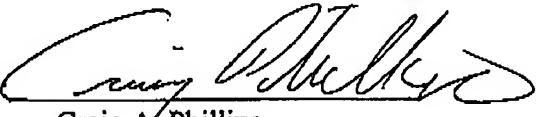
Respectfully submitted,

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